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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/971,960 11/17/97 STILZ H 026083/0138

HM12/1121

EXAMINER

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DAZI,S

ART UNIT	PAPER NUMBER
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1616

24

DATE MAILED:

11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/971,960</b>	Applicant(s) <b>Stilz et al.</b>
	Examiner <b>Sabiha Qazi</b>	Group Art Unit <b>1616</b>

Responsive to communication(s) filed on Sep 19, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 21-24 and 39-103 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 21-24 and 39-103 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Office Action on Merits**

**Status of the application**

Claims 21-24 and 39-103 are pending.

Claims 21-24 and 39-103 are rejected.

No claim is allowed.

Applicant's response in paper no. 22, dated 9/19/2000 is hereby acknowledged. Amendments are entered.

Claims 21-24 and 39-103 rejected under 35 U.S.C. 103(a) as being unpatentable over Zoller et al (US Patent 5,424,293) is withdrawn because claims are amended.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-24 and 39-103 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the inhibitors of the adhesion, migration of leucocytes and/or as antagonists of the receptor VL-4, does not reasonably provide enablement for several methods as claimed in the instant invention, for example, "prevention" and "prophylaxis" of several diseases listed in claims 23-24 are not disclosed. The specification does not enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicant is requested to a complete support for all the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-24 and 39-103 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims last 2 lines in the definition of R6, should be replaced by "optionally substituted by protected or unprotected".

Some minor informalities are noted. In claim 22, in definition of R16, line 4, there is a typing error in "identification". The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Search was limited to elected invention of group II, others were withdrawn from consideration as non elected invention. In order to advance prosecution Applicant is requested to amend the claims while responding to this action.

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**Telephonic Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Sabiha N. Qazi Ph.D.

11/16/2000

**Primary Examiner,**

AU 1616